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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,706	12/30/2003	Mark Lester	1671-0278	2131
28078 7590 03/07/2007 MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/748,706  
Filing Date: December 30, 2003  
Appellant(s): LESTER ET AL.

**MAILED**  
**MAR 07 2007**  
**GROUP 3700**

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James D. Wood  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/22/06 appealing from the Office action  
mailed 7/19/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

3,939,498	Lee et al	2-1976
6,008,431	Caldarise et al	12-1999

5,163,961	Harwin	11-1992
4,889,110	Galline et al	12-1989

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended adding, *"the complementary feature of the implant does not extend completely through the removed portion of bone"* which is new matter. Referring to applicant's figure 6 and specification page 6 which teaches, *"mating feature 25 cut into the bone portion T can extend along the entire cut surface C as represented by the dashed lines in FIG 6"*. The Examiner interprets this as extending completely through the removed portion of bone.

Claims 13-14, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al (3,939,498).

Lee teaches a method for repair of a joint comprising the steps of:  
removing a portion of a bone 53 having natural soft tissue attached thereto;

implanting an implant 10 within the remaining bone leaving an exposed surface of the implant;

preparing a surface of the removed portion of bone to provide the surface with a surface feature (bore 54) to mechanically interlock with a complementary feature (member 20) defined on the exposed surface of the implant', and

mechanically engaging the surface feature of the removed portion of bone with the complementary feature of the implant when the implant is within the remaining bone while the natural soft tissue is still attached to the removed portion of bone.

Regarding claim 10, mechanical fastener, see fastener 40.

Regarding claims 13-18, as far as the scope can be determined, the following is made of record:

Claim 13: stem 13, body 10, mechanical engagement feature 14 or 20. Note that the slot can be used to accept a complementary feature formed in the trochanter. Said opening has "diverging opposing faces" which contain the enlarged end portion 22.

Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Caldarise et al (6,008,431).

Caldarise et al teaches an implant comprising:

A stem 25 configured for implantation in a bone of a joint; and

a head configured to replace a portion of the articulating aspect of the bone, said body including a surface 28 defining a mechanical engagement feature configured to

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engage a complementary feature formed in a removed portion of the articulating aspect of the bone. Regarding the dovetail, see figure 2.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (3,939,498) in view of Harwin (5,163,961) and/or Galline et al (4,889,110).

Lee et al teaches the implant as taught above, however, is silent regarding additional anchoring means of the trochanter. Harwin teaches an screw 9 and hole 10a and Galline et al teaches cerclage cable. It would have been obvious to one having ordinary skill in the art to have utilized either/both of the screw and cable as taught in the art or bone cement which is well known in the art to provide additional anchoring of the implant as deemed necessary by the surgeon.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldarise et al (6,008,431) in view of Harwin (5,163,961) and/or Galline et al (4,889,110).

Caldarise et al teaches the implant as taught above, however, is silent regarding additional anchoring means. Harwin teaches an screw 9 and hole 10a and Galline et al teaches cerclage cable. It would have been obvious to one having ordinary skill in the art to have utilized either/both of the screw and cable as taught in the art or bone cement which is well known in the art to provide additional anchoring of the implant as deemed necessary by the surgeon.

**(10) Response to Argument**

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph

As stated in the Final Office action, the new language added to claim 1, *"the complementary feature of the implant does not extend completely through the removed portion of bone"* is new matter. The Examiner, giving the language it's broadest reasonable interpretation, stated, "[r]eferring to applicant's figure 6 and specification page 6 which teaches, *"mating feature 25 cut into the bone portion T can extend along the entire cut surface C as represented by the dashed lines in FIG 6"*. The Examiner interprets this as extending completely through the removed portion of bone. Appellant argues that the term "can" implies it does not have to extend along the entire cut surface. Again, the Examiner's broadest reasonable interpretation is along the cut surface and not perpendicular to said surface as was the probable intended scope. Regardless of the direction of complementary feature, nowhere in the specification does it explicitly state the claimed configuration.

The Examiner further notes appellant's claim 17 which describes their implant comprising, *"said screw sized to pass through the removed portion of bone when the removed portion is engaged to said body."* The screw extends completely through! In conclusion, *"the complementary feature of the implant does not extend completely through the removed portion of bone"* is not found anywhere in appellant's specification as originally filed and is simply new matter.

Claims 13-14, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al (3,939,498).

Claim 13 claims "*said body including a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the bone*". The Examiner's rejection interprets the body 10 having a surface defining an elongate member (bolt) 20. Appellant argues that said member is a separate component from the main component 10 and the interpretation is unfair. It is the Examiner's position that this interpretation is fair and reasonable; the claim language simply does not exclude this interpretation.

With respect to the additional interpretation, the slot 14 is also interpreted as a "mechanical engagement feature". The Examiner reminds appellant that claim 13 is a device claim, all language regarding the complementary feature formed in the removed portion of bone is merely functional language. It is the Examiner's position that the removed bone portion of Lee et al could be cut producing a complementary feature to slot 14; the device is fully capable of fulfilling the functional language. Further, it is conceivable that removed portion of bone is pressed into the slot via member 20 or following a period of time, the bone grows into slot 14. Either way the functional language is also met wherein the bone portion has a complementary feature.

Regarding claim 19

The Examiner is dumfounded that appellant is arguing that the implant of Lee et al is not implanted. One skilled in the art should be capable of ascertaining directly from the reference that the implant of Lee et al is implanted into the remaining bone 51.



Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by  
Caldarise et al (6,008,431).

Giving the term its broadest reasonable interpretation, any portion of the implant can be interpreted as the body. As stated in the rejection, the body includes a surface 28, which as clearly shown in figure 1, can be on the upper enlarged portion of the implant. This portion is positioned between a stem and a head is typical language known/used in the art and is self-evident.

It is noted that claim 13 is a device claim. All language regarding the complementary feature formed in the removed portion of bone is merely functional language. Caldarise et al teaches the mechanical engagement features 28, 30 include "long trench-like grooves" see 4:17 et seq. The device is fully capable of fulfilling the functional language.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable  
over Lee et al (3,939,498) in view of Harwin (5,163,961) and/or Galline et al (4,889,110)  
or Caldarise et al (6,008,431) in view of Harwin (5,163,961) and/or Galline et al  
(4,889,110).

No additionally arguments were made.

#### **(11) Related Proceeding(s) Appendix**

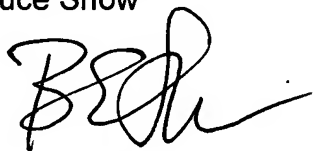
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

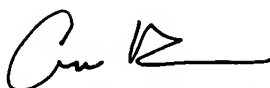
Respectfully submitted,

Bruce Snow



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